

REMARKS

Initially, Applicant would like to express appreciation to the Examiner for the detailed Official Action provided, for the acknowledgment of Applicant's Information Disclosure Statement (IDS) by return of the Form PTO-1449, and for the acknowledgment of Applicant's Claim for Priority and Receipt of the certified copy of the priority documents in the Official Action.

Upon entry of the present amendment, claims 1-5 will have been canceled and claims 6-13 will have been added, with claims 6-13 pending in the present application for consideration by the Examiner. Applicant notes that new claims 6-9 and 11, generally correspond to original claims 1, 2, 3, 5 and 4 respectively, but have been rewritten, *e.g.*, in closer conformance to U.S. patent practice.

The Examiner has objected to the specification because of a typographical error.¹ In compliance with the Examiner's requirement, Applicant has amended paragraph [0033] of the specification, and respectfully request that the Examiner withdraw this objection.

The Examiner has rejected claims 1 and 3-5 under 35 U.S.C. § 102(b) as being anticipated by LAI. Applicant's respectfully traverse the Examiner's rejection, and (as noted *supra*) note that the applied LAI reference fails to teach or suggest at least the claimed electrically-conductive generally planar pad contact face, as recited in independent claims 6 and 11 (which correspond to rejected independent claims 1 and 4). Rather, the

¹ This objection appears under the heading "Claim Rejections – 35 U.S.C. § 112"; however, Applicant assumes that such a heading is in error, and respectfully requests the Examiner's confirmation in this regard.

P24167.A03

pen core 11 of LAI is shown (see, e.g., Figs. 1 and 4-5) as having a rounded portion which engages a touchpad. Thus, it is respectfully submitted that LAI fails to teach or suggest at least the claimed electrically-conductive generally planar pad contact face.

With respect to the Examiner's rejection of dependent claims 3 and 5, Applicant's submits that generally corresponding newly-added claims 8-9 (as well as newly-added claim 10) are dependent from allowable independent claim 6, which is allowable for at least the reasons discussed *supra*. Thus, these dependent claims (as well as newly-added claim 10) are also allowable for at least the reasons discussed *supra*. Further, all dependent claims set forth a further combination of elements neither taught nor disclosed by any of the applied references. For example, LAI is not configured to input data to an information processing apparatus via changes of static capacitance (as claimed in dependent claims 8-9), but rather is directed to a resistive pressure sensitive electromagnetic pen (see, e.g., col. 1, lines 52-53).

Absent a disclosure in a single reference of each and every element recited in a claim, a *prima facie* case of anticipation cannot be made under 35 U.S.C. § 102. Since the applied reference fails to disclose each and every element recited in independent claims 6 and 11 and the claims dependent therefrom, these claims are not anticipated thereby. Accordingly, the Examiner is respectfully requested to withdraw the rejection under 35 U.S.C. § 102.

The Examiner has rejected claim 2 under 35 U.S.C. § 103(a) as being unpatentable over LAI in view of U.S. Patent No. 5,210,405 to TOYODA. Applicant respectfully traverses the Examiner's rejection and note that since generally corresponding newly-

P24167.A03

added claim 7 (as well as newly-added claim 10) are dependent from allowable independent claim 6, which is allowable for at least the reasons discussed *supra*. Thus, this dependent claim (as well as newly-added claim 10) are also allowable for at least the reasons discussed *supra*. Further, all dependent claims set forth a further combination of elements neither taught nor disclosed by any of the applied references. It is thus respectfully requested that the Examiner withdraw the rejection under 35 U.S.C. § 103(a).

Thus, Applicant respectfully submits that each and every pending claim of the present application meets the requirements for patentability at least under 35 U.S.C. §§ 102 and 103, and respectfully requests the Examiner to indicate the allowance of each and every pending claim in the present application.

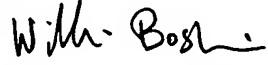
SUMMARY AND CONCLUSION

In view of the fact that none of the art of record, whether considered alone, or in any proper combination thereof, discloses or suggests the present invention, and in further view of the above amendments and remarks, reconsideration of the Examiner's action and allowance of the present application are respectfully requested and are believed to be appropriate.

Applicant notes that this amendment is being made to advance prosecution of the application to allowance and should not be considered as surrendering equivalents of the territory between the claims prior to the present amendment and the amended claims. Further, no acquiescence as to the propriety of the Examiner's rejection is made by the present amendment. All other amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto (e.g., for cosmetic purposes).

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

September 18, 2006
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191

Respectfully submitted,
William S. Boshnick Shoji YAMADA
Reg. No. 44,550 
William Boshnick
Reg. No. 44,550